

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

NOKM.059PA

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on December 18, 2008

Signature: /Rennae Johnson/

Typed or printed name Rennae Johnson

Application Number

10/662,059

Filed

September 12, 2003

First Named Inventor

LEWONTIN

Art Unit

2445

Examiner

Goodchild, W.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the



applicant/inventor.

/William B. Ashley/

Signature



assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

William B. Ashley

Typed or printed name



attorney or agent of record.

Registration number 51,419

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Telephone number



attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

December 18, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below.



*Total of 1 forms are submitted.

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SERIAL NO. 10/662,059

PATENT APPLICATION

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Appellant:	LEWONTIN	Examiner:	Goodchild, W.
Serial No.:	10/662,059	Group Art Unit:	2445
Filed:	September 12, 2003	Docket No.:	NOKM.059PA
Confirmation No.:	8337	Customer No.:	76385
Title:	SYSTEM, APPARATUS, AND METHOD FOR USING REDUCED WEB SERVICE MESSAGES		

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this paper is being electronically transmitted by EFS-WEB to the United States Patent and Trademark Office on December 18, 2008.

By: Rennae Johnson/
Rennae Johnson

**APPELLANT'S STATEMENT IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

This statement is presented by Appellant in compliance with the USPTO OG Notice of 12 July 2005 entitled "New Pre-Appeal Brief Conference Pilot Program," which has been extended until further notice pursuant to the USPTO OG Notice of February 7, 2006. The Appellant is requesting a pre-appeal brief conference on the belief that the rejections of record are not proper and are based on a legal error. Thus, Appellant's request is based upon a clear legal or factual deficiency in the rejections, rather than an interpretation of the claims or the prior art teachings. As such, this request for pre-appeal brief review is appropriate.

If an appeal becomes necessary, there may be issues other than those presented in this statement that may be addressed that may involve an interpretation of the claims or the teachings of the prior art. However, at this time, this statement involves the impropriety of

a cited reference that is used in the rejections of all rejected claims. The Appellant contends that the inclusion of this reference constitutes an appropriate basis for submitting the present statement in support of pre-appeal brief request for review.

Appellant maintains that Cheenath fails to expressly or inherently disclose at least a reduced message that is formed based on at least a variant portion of a Web service message independent Claims 1, 13, 17, 21, 23, 27, and 30. In a Final Office Action mailed October 30, 2008, paragraph 0025 of Cheenath is relied upon to show a reduced message that is formed based on at least a variant portion of a Web service message and sending the reduced message targeted for a second network entity via a network. This paragraph of Cheenath states, in its entirety:

The XML encoded parameters for an RPC web service are placed inside a SOAP envelope and sent to the web service as an HTTP post request. In one embodiment, the web service may have a result or output after receiving the post request. In this case, the result of the HTTP post request is received by the client as an HTTP response wrapped in a SOAP envelope. The response SOAP envelope is then parsed to retrieve the response from the web service.

Here, as elsewhere in the reference, Cheenath is describing a formation and sending of a standard SOAP message. Nowhere does Cheenath state or suggest that the SOAP envelope is “reduced” in any way. The SOAP envelope shown in paragraph 0023, for example, is a fully formed envelope that may be used for remote invocation as described in the first sentence of paragraph 0025. Nowhere does Cheenath describe reducing any of the data contained in this or other SOAP envelopes before invoking a Web service with the envelope.

In response to this argument, the Examiner states at page 13 of the Final Office Action: “Cheenath [at 0021] discloses creating a reduced message...Using setAddress as a way to only request a portion of the available data is a ‘reduced message.’” However, 0021 of Cheenath merely states “parameters or arguments needed to invoke the desired method are converted to XML before being added to the SOAP body element...a ‘setAddress’ method may take the three parameters name, street, and zip...[o]nce the parameters have been added to the body element, SOAP envelope generation is complete.” Thus Cheenath

teaches using three parameters of a Java setAddress method call to form the body of a SOAP element.

The Appellant respectfully submits that those skilled in the art would not conclude that formation of a standard SOAP message based on parameters of a Java function in any way describes the formation of a “reduced message.” The Examiner states in the Office Action that the “instant specification does not define specifically a ‘reduced message’, but states that it ‘can include...’, or ‘may include...’ from various embodiments,” but fails to cite any specific example of what a reduced message “can” or “may” include. Without acquiescing to this statement, alleging that the “specification does not define specifically a ‘reduced message’” still does not relieve the Examiner from considering all words in a claim in judging the patentability of a claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). As a result, this is not an issue of interpretation, but rather an issue of addressing the express claim limitations in the claim, thereby resulting in a legal error versus a factual error.

Appellant further submits that, contrary to the Examiner’s assertion, the Specification includes clear descriptions of a “reduced messages,” (e.g., paragraphs 0023, 0030), and further, these descriptions are consistent with the common meanings of the term “reduced.” The Examiner has not shown, for example, that the SOAP message of Cheenath is reduced in size or reduces network bandwidth compared to a standard SOAP message that performs an equivalent function. Nor does the Examiner’s explanation of the setAddress method explain how the SOAP message formed as a result of the method is in any way reduced. Contrary to the Examiner’s assertion that “setAddress as a way to only request a portion of the available data,” Cheenath shows using all of the parameters when forming the SOAP message. Thus, the Examiner’s rejection of the claims based on Cheenath does not address the express language of the claims, which results in a legal error versus a factual error.

The rejections have also failed to address other express language of the claims, including wherein the Web service message includes a variant portion that changes for repeated invocations of the remote procedure call and an invariant portion that does not

change for the repeated invocations of the remote procedure call. Again, the Examiner references paragraph 0021 of Cheenath to support this, but fails to set forth what the Examiner considers to be “invariant portions of the message,” nor does Cheenath expressly describe such portions. Inasmuch as the Examiner relies on Cheenath to inherently show variant and invariant portions of a Web service message, the Examiner has nonetheless failed to show forming a reduced message based on a variant portion, at least because as stated above Cheenath fails to describe any reduced messages at all.

The Appellant notes that the above arguments do not present issues of claim interpretation, but rather addresses the issue of whether the Office is giving weight to limitations recited in the claims. The Appellant submits that claimed limitations are not being given the proper weight by the Office during prosecution, and discounting such claim limitations results in an error of law.

Each of the pending dependent claims are dependent from the independent claims discussed above. These dependent claims include all of the limitations of their respective independent claim and any intervening claims, and the arguments above are equally applicable to each of the dependent claims. Further, the rejections of dependent Claims 4, 10, 32, and 34 under 35 USC § 103(a) rely on Cheenath to teach or suggest the substance of the independent claims from which these claims depend. The secondary references, Kuznetsov and Multer et al., fail to cure the deficiencies of Cheenath in this respect, therefore the rejection of Claims 4, 10, 32, and 34 is also in error.

Notwithstanding other potential issues for appeal that may be outside the scope of this statement in support of pre-appeal request for review, at least the aforementioned limitations have not been properly considered. For at least these reasons, the rejections based on Cheenath are grounded in an error of law. The Appellant respectfully submits that the resulting error of law compels reversal of these rejections.

The undersigned attorney of record may be contacted at 952.854.2700 (ext. 12) to discuss any issues related to this case.

Respectfully submitted,

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Date: December 18, 2008

By: /William B. Ashley/

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